

REMARKS

Claims 1-4 and 6-39 are present in the application and pending on the merits. For at least the reasons outlined herein, Applicant respectfully requests reconsideration and withdrawal of the claim objection and rejections, and allowance of pending claims 1-4 and 6-39.

I. Objection under 37 C.F.R. § 1.75

Claim 39 was objected to under 37 C.F.R. § 1.75, based on an assertion that claim 39 is "a substantial duplicate of claim 26." Office Action at 2. In particular, the Office Action asserts that "when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim." Id. at 2 (emphasis added) (citing M.P.E.P. § 706.03(k)). Applicant respectfully submits that such an objection is proper only "after allowing one claim . . ." M.P.E.P. § 706.03(k) (emphasis added). Because claims 26 and 39 currently stand rejected, Applicant respectfully submits that the objection to claim 39 is improper. Therefore, Applicant respectfully requests reconsideration and withdrawal of this claim objection.

II. Claim Rejections under 35 U.S.C. § 103(a)

In the Office Action, claims 1-4, 6, 13-18, 26, 27, 29, 30, 34-37, and 39 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 3,754,712 to Cecil (Cecil).

Office Action at 2. In addition, claims 23-25 and 33 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 5,718,756 to Mohler (Mohler). Id. at 4. Claim 28 was rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 3,309,214 to Joseph et al. (Joseph). Id. at 5. Claims 7, 8, and 10-12 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 4,423,118 to Corbett et al. (Corbett). Id. at 6. Claims 7-10, 31, 32, and 38 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 5,799,978 to Grinnell (Grinnell) and U.S. Patent No. 4,716,186 to Portnoy et al. (Portnoy). Id. at 8. Claims 19-22 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 6,171,702 to Malhotra et al. (Malhotra), "as evidenced by" U.S. Pat. App. No. 2001/0051230 to Colton et al. (Colton) "and/or" U.S. Patent No. 4,686,260 to Lindemann et al. (Lindemann). Id. at 10.

Applicant respectfully submits that the rejected claims are patentably distinguishable from the references relied on in the claim rejections, and requests reconsideration and withdrawal of the claim rejections for at least the reasons outlined below.

a. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil

Claims 1-4, 6, 13-18, 26, 27, 29, 30, 34-37, and 39 were rejected under 35 U.S.C. § 103(a) based on Cecil. Office Action at 2. Claims 1, 29, 36, 37, and 39 are the only independent claims included in that claim rejection, and Applicant respectfully

submits that those claims are patentably distinguishable from Cecil for at least the reasons outlined below.

Applicant notes that this claim rejection was included in the final Office Action mailed May 23, 2008. In Applicant's Amendment After Final filed on August 19, 2008, Applicant submitted evidence supporting Applicant's traversal of this claim rejection that the Office improperly failed to consider. Therefore, if in response to Applicant's further remarks below regarding the impropriety of this claim rejection, the Examiner refuses to withdraw this claim rejection and issues a new Office Action, Applicant respectfully requests that the Examiner kindly provide (1) a substantive response to Applicant's written remarks, including an explanation of the purported reasons why Applicant's written remarks, bolstered by evidence in the record, are not persuasive, and (2) designate such Office Action non-final, so that Applicant will be provided with a fair opportunity to respond appropriately.

In the "Response to Arguments" section, the Office Action asserts that Applicant's written remarks showing that "independent claims 1, 29, and 37 are not obvious over Cecil under 103 rejection because those claims recite a range that is critical as evidenced by unexpected results achieved, at least in part, due to the recited range," is allegedly insufficient because "no tangible evidence and/or experimental results have been submitted to compare the instant invention and that of the prior art to show unexpected results." Office Action at 12. The Office Action further asserts that "[a]rguments cannot take the place of evidence in the record to overcome rejection." Id. (citing M.P.E.P. § 2145).

Applicant respectfully submits that the Office Action has mischaracterized Applicant's identification of evidence in the record rebutting the rejection as "arguments." According to the M.P.E.P., "[t]he Office is required to consider all rebuttal arguments and evidence presented by applicants. . . . [and] Office personnel should avoid giving evidence no weight, except in rare circumstances." M.P.E.P. § 2145. Further, it is established law that it is "error not to consider evidence presented in the specification." Id. (citing In re Soni, 54 F.3d 746, 750 (Fed. Cir. 1995)) (emphasis added). Thus, Applicant's reference to portions of the originally-filed specification, which support the criticality of the ranges recited in the claims and the unexpected results, provides evidence in the record—not mere "arguments"—that must be considered by the Office.

Thus, without agreeing with the assertion that Applicant's independent claims 1, 29, 36, 37, and 39 and Cecil respectively recite and disclose overlapping ranges related to particle size, Applicant respectfully submits that, even if for the sake of argument, overlapping ranges are present, independent claims 1, 29, 36, 37, and 39 are not prima facie obvious based on Cecil. Rather, at least because those claims recite ranges that are critical, as evidenced by the unexpected results disclosed in Applicant's originally-filed specification, at least those ranges render the claims patentably distinguishable from Cecil.

As previously outlined by Applicant, the M.P.E.P. provides that a prima facie case of obviousness based on overlapping ranges is rebuttable by showing the criticality of the claimed range through, for example, a showing of unexpected results.

Amendment After Final (dated 08/19/08) at 14-16 (citing § 2144.05(III)). Thus, even if for the sake of argument, the rejection statement were to hypothetically establish a prima facie case of obviousness based on an overlapping ranges assertion, such a prima facie case may be overcome by showing evidence in the specification that the ranges recited in the claims are critical. See id.; M.P.E.P. § 2145. In Applicant's previous response, Applicant identified evidence in the record to rebut the hypothetical prima facie case of obviousness, as follows:

Applicant respectfully submits that the range recited in Applicant's independent claims 1, 29, and 37 is critical, as evidenced at least by virtue of the high-solids composition, as recited in independent claims 1, 29, and 37, having achieved unexpected results. For example, the high-solids compositions recited in independent claims 1, 29, and 37 unexpectedly retain the gloss, brightness, and/or sheen generally only associated with compositions that included higher volumes of calcined kaolin to attain a similar level of gloss, brightness, and/or sheen. See, e.g., Applicant's Description at pp. 18-19, ¶ [063]. In addition, the recited high-solids compositions exhibit exceptional stability relative to prior compositions, and further may be more desirable because an associated minimized volume of the slurries may allow for ease of handling and/or reduction of transport costs. See, e.g., id. at p. 3, ¶¶ [012], [013]; p. 15, ¶ [061].

Amendment After Final at 15. Note the specific references to the specification (i.e., at pages 18-19, ¶ [063], page 3, ¶¶ [012], [013], and page 15, ¶ [061]), which constitute tangible evidence in the record that the Office must consider. M.P.E.P. § 2145. As such, the Office's failure to consider this evidence provided by Applicant is improper.

Moreover, the M.P.E.P. requires that once Applicant provides evidence of unexpected results, that evidence "must be weighed against evidence supporting prima facie obviousness in making a final determination of the obviousness of the claimed invention." § 706.02(c). Similarly, when Applicant "timely submits evidence traversing a

rejection, the examiner must reconsider the patentability of the claimed invention," and "facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself."

§ 716.01(d) (emphasis added). The M.P.E.P. further requires that "if, after evaluating the evidence, the examiner is still not convinced that the claimed invention is patentable, the next Office Action should include a statement to that effect and identify the reason(s)." Id. Failing to comply with these guidelines, the Office Action improperly fails to consider the evidence in the specification (i.e., evidence in the record) by mischaracterizing it as "argument" with "no tangible evidence and/or experimental results" Office Action at 12.

For at least the above-outlined reasons, the compositions and methods recited in independent claims 1, 29, 36, 37, and 39 of the present application exhibit unexpected results, rendering those claims patentably distinguishable from Cecil. Therefore, Applicant respectfully requests reconsideration of this rejection in light of the evidence of unexpected results presented in this and Applicant's previous response, and respectfully requests withdrawal of the rejection of independent claims 1, 29, 36, 37, and 39 under 35 U.S.C. § 103(a) based on Cecil.

Claims 2-4, 6, 13-18, 26, 27, 30, and 34 each depend from a corresponding one of claims 1 and 29. For at least this reason, claims 2-4, 6, 13-18, 26, 27, 30, and 34 should be patentably distinguishable from Cecil, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims under § 103(a) based on Cecil.

1. Rejection of Claim 39

Claim 39 was rejected under 35 U.S.C. § 103(a) based on Cecil. Office Action at 2. The rejection statement asserts that "Cecil disclose[s] calcined kaolin clay slurry ha[ving] a specific particle size distribution and solids content," and further, that "Cecil[] also[] discloses the possibility of adding the slurry into a mill (for example, ball mill) to grind it (column 3, lines 63–66; column 4, lines 30–34)." Id. at 4.

Applicant's independent claim 39 is directed to a composition comprising a slurry comprising calcined kaolin, "wherein the calcined kaolin has not been subjected to mechanical grinding." (Emphasis added.) Applicant respectfully submits that Cecil fails to disclose or render obvious at least the subject matter recited in independent claim 39. Indeed, in stark contrast to the recited subject matter, Cecil discloses kaolin clay that has undergone grinding/ball milling. See, e.g., Cecil at col. 6, ll. 29-33 (claiming a method requiring "wet milling said suspension in the presence of grinding media having a specific gravity above 3 until the viscosity of the clay is reduced sufficiently to permit the addition of more clay without stopping the mill"); Cecil at col. 6, ll. 48-52 (claiming a method requiring "ball milling the resulting slurry with ceramic milling media having a specific gravity above 3 until the viscosity of the suspension is reduced, adding increments of calcined clay, each increment being followed by further ball milling").

The rejection statement relating to claim 39 asserts that "Cecil . . . discloses the possibility of adding the slurry into a mill (for example, ball mill) to grind it (column 3, lines 63-66; column 4, lines 30-34)." Office Action at 4. Applicant respectfully notes that the subject matter referenced by the rejection statement does not result in

disclosing a calcined kaolin, "wherein the calcined kaolin has not been subjected to mechanical grinding," as recited in independent claim 39. (Emphasis added). Indeed, the rejection statement has failed to identify any disclosure in Cecil that purportedly supports the Office Action's rejection of claim 39 under § 103(a) based on Cecil.

For at least the above-outlined reasons, Applicant respectfully submits that Cecil fails to disclose or render prima facie obvious all of the subject matter recited in Applicant's independent claim 39. Thus, independent claim 39 is patentably distinguishable from Cecil, and Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 39 under § 103(a) based on Cecil.

b. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil in view of Mohler

Claims 23-25 and 33 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with Mohler. Claims 23-25 and 33 depend respectively from independent claims 1 and 29. Thus, claims 23-25 and 33 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claims 1 and 29. Moreover, Mohler fails to overcome the above-outlined deficiencies of Cecil, and thus, Cecil and Mohler, regardless of whether they are viewed individually or as a whole, fail to render claims 23-25 and 33 prima facie obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 23-25 and 33 under 35 U.S.C. § 103(a) based on Cecil and Mohler.

c. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil in view of Joseph

Concerning the rejection of claim 28 under 35 U.S.C. § 103(a) based on Cecil in combination with Joseph, claim 28 depends from independent claim 1. Thus, claim 28 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claim 1. Moreover, Joseph fails to overcome the above-outlined deficiencies of Cecil, and thus, Cecil and Joseph, regardless of whether they are viewed individually or as a whole, fail to render claim 28 prima facie obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claim 28 under 35 U.S.C. § 103(a) based on Cecil and Joseph.

d. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil in view of Corbett

Concerning the rejection of claims 7, 8, and 10-12 under 35 U.S.C. § 103(a) based on Cecil in combination with Corbett, claims 7, 8, and 10-12 depend from independent claim 1. Thus, those claims should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claim 1. Moreover, Corbett fails to overcome the above-outlined deficiencies of Cecil. Thus, Cecil and Corbett, regardless of whether they are viewed individually or as a whole, fail to render claims 7, 8, and 10-12 prima facie obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claims 7, 8, and 10-12 under 35 U.S.C. § 103(a) based on Cecil and Corbett.

**e. Claim Rejection under 35 U.S.C. § 103(a) based on
Cecil in view of Grinnell and further in view of Portnoy**

Concerning the rejection of claims 7-10, 31, 32, and 38 under 35 U.S.C. § 103(a) based on Cecil in combination with Grinnell and Portnoy, claims 7-10, 31, and 32 depend respectively from a corresponding one of independent claims 1 and 29. Thus, claims 7-10, 31, and 32 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claims 1 and 29. Moreover, Grinnell and Portnoy fail to overcome the above-outlined deficiencies of Cecil. For at least this reason, Cecil, Grinnell, and Portnoy, regardless of whether they are viewed individually or as a whole, fail to render claims 7-10, 31, and 32 prima facie obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claims 7-10, 31, and 32 under 35 U.S.C. § 103(a) based on Cecil, Grinnell, and Portnoy.

Concerning the rejection of independent claim 38, the rejection statement asserts that independent claim 38 is rejected based on Cecil, "as applied to claims 1 and 29 above." Office Action at 8. Thus, claim 38 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claims 1 and 29. Moreover, Grinnell and Portnoy fail to overcome the above-outlined deficiencies of Cecil. Thus, Cecil, Grinnell, and Portnoy, regardless of whether they are viewed individually or as a whole, fail to render independent claim 38 prima facie obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of

the rejection of independent claim 38 under 35 U.S.C. § 103(a) based on Cecil in combination with Grinnell and Portnoy.

f. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil in view of Malhotra “as evidenced by” Colton “and/or” Lindemann

Concerning the rejection of claims 19-22 under 35 U.S.C. § 103(a) based on Cecil in combination with Malhotra “as evidenced by” Colton “and/or” Lindemann, claims 19-22 depend from independent claim 1. Thus, claims 19-22 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claim 1. Moreover, Malhotra (even “as evidenced by” Colton “and/or” Lindemann) fails to overcome the above-outlined deficiencies of Cecil. Thus, Cecil, Malhotra, Colton, and Lindemann, regardless of whether they are viewed individually or as a whole, fail to render claims 19-22 obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claims 19-22 under 35 U.S.C. § 103(a) based on Cecil in combination with Malhotra “as evidenced by” Colton “and/or” Lindemann.

III. Conclusion

For at least the above-outlined reasons, Applicant's independent claims 1, 29, and 36-39 should be allowable. Dependent claims 2-4 and 6-28 depend from allowable independent claim 1. Consequently, those dependent claims should be allowable for at least the same reasons independent claim 1 is allowable. Dependent claims 30-35

depend from allowable independent claim 29. Thus, those dependent claims should be allowable for at least the same reasons independent claim 29 is allowable.

For at least the above-outlined reasons, Applicant respectfully requests reconsideration of this application, withdrawal of the claim objection and claim rejections, and allowance of all of pending claims 1-4 and 6-39.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.

Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this Request, and charge any additional fees to Deposit Account 06-1916.

Respectfully submitted,

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